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10/091,984	03/06/2002	Min Ming Tarn		6341

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Min Ming Tarn, Ph.D.
4225 Borina Drive
San Jose, CA 95129

EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,984

Applicant(s)

TARNG ET AL.

Examiner

Michael Chambers

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

In response to the outstanding rejections of this Office Action, it should be noted that each applicant must sign the response, since each applicant has authority to prosecute the application. However, the applicants have the right to grant one of the applicants Power of Attorney, according to 37 CFR 1.34, for this application.

Election/Restrictions

Applicant's election without traverse of Group I in Paper No. 4 is acknowledged. The following claims read on group I- Claims 1, -10. The additional claims noted by applicant are found in different groups and are not part of group I devices. Claims 11-20 are withdrawn from further consideration, as being directed to non-elected claims. In paper No. 3, 37CFR1.142.

Specification

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph.

A substitute specification which includes the claims is required pursuant to 37 CFR 1.125(a) because the specification appears to be a literal translation of a foreign text. The specification appears to be a narrative explanation of the invention and provides no useable information as to the metes and bounds of the invention or how it is

used. The substitute specification should be proof read prior to submission to insure an accurate and correct document is submitted. Some examples of the terms and sentence fragments are noted below:

Page 1: The golfrisbee disk is thrown into the sky and spin fast.

Page 1: In the northern cold place the golf is limited to be a game during the daytime of the weekend in the warm seasons only.

Page 2: In the golh sport, the golfball is strictly limited to roll on the ground such as putting the ball to roll into the hole.

Page 2: Because there is no flying golfball, so golh is relatively safe to be played in the park to be the Park Golh.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other

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information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required if the applicant continues this application. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of each inventor ("resource of civilization" is not a proper response).

Abstract

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it does not describe the invention. It appears the applicant has inserted an abstract from another application i.e. basedisk. Correction is required if the applicant decides to continue prosecution. See MPEP § 608.01(b).

Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Specification

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are listed below (Note, this is not an inclusive list):

Page 1, line 6- The term "golh" has not been clearly defined. It is not clear if this is a typographical error for the term "golf" or a term developed by the inventor. It should be noted that since it is similar to the term "golf" the term appears to be a typographical error. And although the applicant is permitted to select and define their own terms , it is confusing to the reader if the novel terms selected are perceived to be a typographical errors. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term.

The substitute specification should be proof read prior to submission to insure an accurate and correct document is submitted. Some examples of the terms and sentence fragments are noted below:

Page 1: The golfrisbee disk is thrown into the sky and spin fast.

Page 1: In the northern cold place the golf is limited to be a game during the daytime of the weekend in the warm seasons only.

Page 1: "Golf was invented for several centuries."

Page 2: In the golh sport, the golfball is strictly limited to roll on the ground such as putting the ball to roll into the hole.

Page 2: Because there is no flying golfball, so golh is relatively safe to be played in the park to be the Park Golh.

Page 29, line 9- "The screw mechanism of golfrisbee is a complicate mechanism"

Page 31, line 13- "minimize the accident".

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71 (a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the application fails to adequately teach how to make and/or use the invention. Although the application calls for a frisbee type game, it does not clearly disclose how to make and use the invention. The apparatus should be disclosed in a clear and concise way which would permit one skilled in the art to make the instant invention without undue experimentation. The application broadly describes the invention but not in a clear and concise manner. It is not clear from the specification what the invention is or what the

metes and bounds of the invention are. The specification reads as a narrative account of various games and devices that may be used but fails to clearly define the invention or how to make and use the device.

In addition, objection is made to the drawings as not being in compliance with 37CFR 1.83 and 1.84 and MPEP 608.02 making the disclosure difficult to understand. It is unclear to the examiner the purpose of function of the device and how it operates. For example the specification notes that a motor is optional but does not clearly explain its purpose of how it functions (page 15, paragraph 3).

Claims 1 - 10 are rejected under 35 USC, 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not apparent from the specification what the described structure is, how it is manufactured ,how it functions or what each part is intended to do. See comments made above in the preceding paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

As to claims 1 and 10: The terms "golh", "being in circular symmetrical structure", "thicker than other portion" and " having smooth transitional curve" are vague and indefinite.

As to claim 2: The terms "golh", "being in circular symmetrical structure" and " having smooth transitional curve" are vague and indefinite.

As to claim 3: The terms "golh", "skirt means attaching", "stub means" and " being space " are vague and indefinite.

As to claim 4: The term "soft material " is vague and indefinite.

As to claim 5: The terms "golh", and "being a hole " are vague and indefinite.

As to claim 6: The term "being segments " is vague and indefinite.

As to claim 7: The terms "accessories to increase weight", and " golffrisbee to have sky-ballet spinning launching effect " are vague and indefinite.

As to claim 8: The term "lighting means is to shine light in the night golh sport" is vague and indefinite.

As to claim 9: The term "sound means generate sound in the snow golh sport to guide golher" is vague and indefinite.

Regarding the claims, the word "means" is preceded by the word(s) "golfrisbee, golh club, head, cavity, skirt, small stub in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the

equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ e94 (Bd. App. 19e7).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Weiss. Weiss discloses a circular frisbee , a ring band at the rim of said frisbee, said ring having a smooth transitional curve to the outside and inside edge.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Manes. Manes discloses a golf frisbee, a circular skirt attached with small stubs (fig 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss as applied to claim 1 above. No criticality is seen in the attachment means uses. It would have been obvious to one of ordinary skill in the art at the time of the invention

to have employed any one of several equivalent attachment means depending on the manufacturing method used and manufacturing costs.

As to claims 3 and 4: Weiss discloses a skirt made of soft material (fig 1, 2:17-19).

As to claim 6: The middle portion of Weiss would act as an airfoil (fig 1).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss as applied to claim 1 and further in view of Wilson et al. Wilson et al discloses accessories to increase weight (fig 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the weight of Wilson et al with the device of Weiss in order to increase the distance the disk would fly when launched.

Claims 5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 in view of Official Notice. Weiss does not disclose a hole. Official Notice is taken that it is well known in the art to place holes, sound means and light means on a flying disk. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the disk of Weiss to include a central hole, light and sound means in order to have the disk travel farther or make using the device more enjoyable to use.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

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Michael Chambers
Examiner
Art Unit 3711

July 25, 2003

As to claims 11, 15,16 , 17,19,and 20: The claim is unclear, vague and indefinite.

As to claim 12: The terms "golh", "mounted", "launching head" and " golh club" are vague and indefinite.

As to claim 13: The terms "golh", "weight means", and "pole for training purpose" are vague and indefinite.

As to claim 14: The terms "golh", "cavity of", "launching head means" and " screw means" are vague and indefinite.

As to claim 18: The terms "golh", "simulator means", "sensor means" and " sensing stress and dynamics behavior of " are vague and indefinite.



Paul T. Sewell
Supervisory Patent Examiner
Group 3700